

the broadening aspects, in the reissue, relates to subject matter that applicant's previously surrendered during the prosecution of the application. Applicant, with respective claims 30-32, respectfully transverses this position by the patent office.

Before discussing claims 30-32 it will be beneficial to review the prosecution history of U.S. Patent 5,788,178 (the '178 patent). Essentially, claims 1 and 11 are the only independent claims in the '178 patent and each of these claims was amended during prosecution. First, with respect to claim 1 the steering control means was amended to recite that the control means includes "at least deployable flap means being outwardly extensible from said bullet to deflect air flow about said bullet to impart a correctional momentum to translate said bullet to said optimum trajectory". Essentially, the control means element of claim 1 was amended to more particularly recite that the control means included deployable flaps.

Additionally, claim 1 was amended to recite that the bullet is fired from a precision smooth bore weapon so as to not impart actual spin to said bullet in the manner of a rifle.

Turning to claim 11, this is a method claim for guiding an in-flight bullet along and optimum trajectory. The method as set forth in claim 11 originally recited the step of firing said bullet at said target. This step was amended to add "from a precision sniper rifle having a smooth internal bore".

Claim 30 recited herein does not attempt to recapture any subject matter given up in the course of the prosecution of the '178 patent. Viewing claim 30, it is directed to a method of generating signals on board a bullet that indicates the general orientation of the bullet relative to a target. The claim recites sensing the reflection of light reflected off

the target by at least two (2) light detectors carried on the bullet; each light detector generating an electric signal that is a function of the intensity of the reflected light sensed by the light detector; and comparing, on board the bullet, the electrical signals of each light detector in producing an output signal that is a function of the bullet reorientation required to cause the generated electrical signals to approximate or equal each other.

Clearly, claim 30 in no way attempts to reclaim subject matter that was surrendered in the prosecution of the '178 patent. The subject matter of claim 30 has nothing whatsoever to do with the steering control means recited in claim 1 of the '178 patent. Indeed, the method recited focuses on a method or process for generating signals on the bullet that indicate the general orientation of the bullet relative to a target. There is nothing whatsoever contained in claim 30 that relate to the steering control means and consequently there is no recapture with respect to the steering control means. Further, the method of claim 30 does not deal with the nature or the characteristics of the weapon that the bullet would be fired from. Indeed as already articulated, the method of claim 30 only deals with a method or process for generating signals on board the bullet that indicates the general orientation of the bullet relative to a target. To the extent that claim 30 is deemed to be broadened, none of the broadening language relates to the subject matter that was surrendered with respect to claim 1 of the '178 patent.

Likewise, claim 30 does not recapture subject matter surrendered by amendments related to claim 11 of the '178 patent. Again, claim 11, as originally filed, included a step relating to firing the bullet at a target. Claim 30 does not entail a step or act of firing the bullet to the target. Again, the method is directed to generating signals on board the bullet that indicate the general orientation of the bullet relative to a target. To the extent

that claim 30 is broader than claim 11, it in no way attempts to reclaim what was surrendered in the prosecution of claim 11.

Now turning to claim 32, this claim is directed to a bullet having an on-board system for determining the orientation of the bullet with respect to a target. Basically, claim 32 defines a bullet that includes at least two (2) light detectors carried on board the bullet for sensing light reflecting off the target and each light detector functioning to generate an electrical signal that is a function of the intensity of the reflected light sense. Finally, claim 32 calls for an on-board logic circuit for comparing the electrical signals of each light detector and producing an output signal that is a function of the reorientation of the light detectors required to cause the generated electrical signals of the light detectors to approach or equal each other.

Comparing claim 32 to claim 1 of the '178 patent it is seen that the claim attempts to recapture nothing relating to the steering control means. Indeed the steering control means is not even recited in claim 32 at all. Further, claim 32 does not recite any structure or feature relating to the barrel from which the bullet is fired. Consequently, there can be no recapture here. In short, to the extent that claim 32 is considered in any way to be broadening, the broadening in no way attempts to reclaim what was surrendered during the prosecution of the '178 patent.

It is well settled that the recapture rule does not apply when the broadening of a reissue claim only relates to aspects of the issued claim that was never narrowed to overcome prior art. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 997). In this case, it is clear that the broadening aspects of claims 30 and 32 do not attempt to reclaim any subject matter that was surrendered in the prosecution of the '178 patent.

In reality, claims 30 and 32 are claims that define inventions that were not presented in the original prosecution. The Federal Circuit has made it clear that a primary purpose of the reissue statute is to permit an applicant to present claims to subject matter that were not claimed in the original patent application. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F. 3d 1340, 48 USPPQ2d 1225 (Fed. Cir. 1998). In the C.R. Bard case, the patent that was reissued had claimed only a device for taking samples of body tissues for biopsy purposes. One component of that device was a needle assembly, but the needle assembly was not claimed separately in the original patent. However, the needle assembly was claimed separately in the reissue patent. Here, as noted above, the Federal Circuit held that even though the needle assembly had not been claimed in the original application that new claims to the needle assembly standing alone were appropriately presented in the reissue application.

For the reasons set forth above, it is respectfully urged that claims 30, 31, and 32 are in condition for allowance and the patent office is respectfully requested to reissue the '178 including claims 30-32.

Respectfully submitted,

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